

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:

Doris HUBLER et al.

Group Art Unit 1614

Serial No.: 10/798,780

Examiner: San Ming R. Hui

Filed: March 12, 2004

Confirmation No: 5621

For: METHODS AND PHARMACEUTICAL COMPOSTIONS FOR RELIABLE  
ACHIEVEMENT OF ACCEPTABLE SERUM TESTOSTERONE LEVELS

**RESPONSE TO REQUIREMENT FOR RESTRICTION**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In response to the Office Action mailed September 20, 2007, and the restriction requirement set forth therein, Applicants hereby elect Group I, claims 1-6 and 20-25, drawn to compositions comprising a testosterone ester and a vehicle. The election is made with traverse for the reasons set forth below. Applicants reserve the right to file one or more divisional applications directed to the non-elected subject matter.

The restriction is between the elected Group I and Group II directed to methods of treatment using the compositions. The basis stated in the Office action for supporting the restriction is that the methods of treating can be practiced with a materially different product. Applicants respectfully traverse the restriction on this basis. Historically, a restriction between a product and a process of use was not imposed on the basis that the method can be practiced with a materially different product. The reasoning for this historical practice is sound and remains sound. A method which is conducted with a materially different product will not result in the same method. A materially different product has different properties. Thus, practicing the method with a materially different product will result in a materially different method, not the same method. As a result, the basis factual basis for the restriction is not supported and the restriction should be withdrawn.

Applicants note that the comments in the Office action regarding rejoinder of claims.

Should the restriction requirement be maintained, it is believed the method claims would be suitable for rejoinder.

For all of the above reasons, it is urged that the restriction requirement should be withdrawn, in total. Favorable action is earnestly solicited.

No fee is believed due with this response, however, the Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

/John A. Sopp/

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Attorney Docket No. PLOVIN-0010

Date: October 22, 2007

JAS/cak